

REMARKS/ARGUMENTS

Claims 37 – 69 are pending in the application with claims 54 – 69 being withdrawn.

Applicants appreciate the indication that claim 49 would be allowable. However, in view of the amendments to the claims as well as the following comments, it is respectfully submitted that all of the pending claims should now be allowable.

With regard to the unity of invention issue, although Applicants would be willing to cancel the withdrawn claims if no common element is finally found to be present in all of the claims, Applicants respectfully submit that the present finality of the requirement is premature, and Applicants continue to traverse the restriction requirement. In particular, the present Office Action is not a Final Rejection, and in fact is the first substantive rejection of claims based on art. Therefore, based upon the following arguments and the amendments to the claims, it is respectfully submitted that a common element (namely an adhesive film that is adhesive on a first side, which is applied to a data carrier surface, and is non-adhesive on a second, opposite side that forms a transparent protective layer) should now be found allowable, in which case there would certainly be unity of invention and all of the claims could remain in the application. In other words, the PCT rule 13.2 requirement regarding unity of invention would be fulfilled, i.e. the group of inventions would be considered linked to form a single general inventive concept, because there is a technical relationship among the inventions that involves at least one common or corresponding technical feature (in other words, the claims do not have to be "identical"; please see the fifth paragraph of MPEP section 1893.03(d)).

Applicants therefore respectfully request withdrawal of the finality of the restriction requirement. The Examiner's attention is also respectfully directed to the third paragraph of MPEP section 1893.03(d), which makes it clear that restriction practice does not apply to national stage applications. Therefore, 37 CFR 1.44 and MPEP section 821.01 are not applicable (see also MPEP section 801).

With regard to the claims being differently classified, it is respectfully submitted that this is not an appropriate criterion under unity of invention rules. As noted above, for unity of invention to exist, the independent claims under discussion clearly do not have to be "identical" with regard to the recitation of features. They merely have to have one common or corresponding technical feature, in other words a single general inventive concept, which here, as also indicated above, is an adhesive film that is adhesive on a first side, which is applied to a data carrier surface, and is non-adhesive on a second, opposite side that forms a transparent protective layer. The Examiner's attention is also respectfully directed to 37 CFR 1.475.

With regard to the claim rejections, independent claims 37, 54 and 65 have been amended to clarify and emphasize that they relate to the coating of an optically readable data carrier by means of an adhesive film that is adhesive on one side, which is applied to the data carrier, while the other, non-adhesive side forms a transparent protective layer for the data-carrying surface of the optically readable data carrier. Support for the amended language of these claims can be found, for example, on pages 4, 8 and 12 of the specification, as well as in original claim 52, which disclosed a transparent protective layer on the non-adhesive side of the adhesive film.

The Examiner has rejected, among others, claim 37 under 35 USC 102(e) over Amo. Although the following arguments are directed specifically to claim 37, they are also applicable to the remaining independent claims 54 and 65.

As indicated above, the method of the present application relates to the coating of an optically readable data carrier, according to which a transparent adhesive film that is adhesive on a first side is applied to a data carrier surface that is to be protected, wherein a second, opposite non-adhesive side forms a transparent protective layer.

As a consequence of the inventive method, it is now possible to form a protective layer on an optically readable data carrier in a single step. In the past, such a coating was produced by a lacquer that was to be cured and that was applied in a central region onto a rapidly rotating data carrier; due to the centrifugal force, the lacquer was caused to flow outwardly, as described on page 1 of the specification of the instant application. This then resulted in the drawbacks also described on page 1 of the specification.

The Amo reference discloses an apparatus and a method according to which two or more essentially identical substrates, each of which carries its own optical information, are glued together to form a data carrier. For this purpose, Amo first applies a transparent adhesive film, which is adhesive on both sides, to a disc-shaped substrate; a release paper is subsequently withdrawn from the adhesive film, which as indicated above is adhesive on both sides. Subsequently, a second substrate is brought into contact with that side of the double-adhesive sided film that has been exposed, in order to glue the two disc-shaped substrates together.

Applicants furthermore respectfully submit that Amo is not a proper reference under 35 USC 102 pursuant to the guidelines set forth in the last paragraph of MPEP section 2131, where it is stated that "a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference", and that "the identical invention must be shown in as complete detail as is contained in the ... claim". In particular, Amo does not describe the coating of an optically readable data carrier pursuant to the step defined in Applicants' claim 37. Rather, Amo discloses the gluing together of two substrates. In addition, Amo does not disclose the feature, required by Applicants' claim 37, that the adhesive film have a first, adhesive side that is applied to the data carrier surface, as well as a second, non-adhesive side that forms a transparent protective layer, as a consequence of which it is possible within a single step to apply a protective layer for the data carrying surface of an optically readable data carrier.

Thus, it is respectfully submitted that claim 37 of the instant application is clearly distinguishable from the Amo reference, which discloses the gluing together of two essentially identical substrate halves.

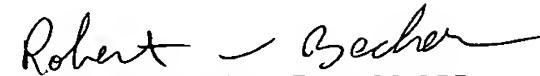
It is also respectfully submitted that the further cited references also do not teach or suggest the application or coating of an optically readable data carrier with an adhesive film that is adhesive on only one side. Again, these references all deal with the gluing together of two essentially identical substrate halves.

In view of the foregoing discussion, Applicants respectfully request reconsideration of the allowability of all of the pending claims 37 – 69 of the present application. Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call from him in order to be able

Appl. No. 10/018,143
Amdt. Dated August 26, 2004
Reply to Office Action of February 26, 2004

to discuss any outstanding issues and to expedite placement of the application into condition for allowance.

Respectfully submitted,


Robert W. Becker, Reg. 26,255
Attorney for Applicant(s)

ROBERT W. BECKER & ASSOCIATES

707 Highway 66 East, Suite B
Tijeras, New Mexico 87059

Telephone: 505 286 3511
Telefax: 505 286 3524

RWB:mac